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10/748,352	12/30/2003	Martin Finnerty	SBL0029US	7797
60/975 7590 03/18/2008 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER				
LEE, CHUN KUAN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,352

Applicant(s)

FINNERTY ET AL.

Examiner

Chun-Kuan Lee

Art Unit

2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

RESPONSE TO ARGUMENTS

1. Applicant's arguments filed 02/19/2008 have been fully considered but they are not persuasive. Currently, claims 37-39 are canceled and claims 1-36 are pending for examination.
2. In response to applicant's arguments (on page 10, last paragraph to page 12, 1st paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that the combination of references do not teach/suggest every claimed limitations because Wakai does not teach/suggest the applet that provides the request to provide the requested service, because in Figure 2 there is no explicit disclosure of the above claimed feature as the applet that provide a request to provide a service need not be necessary present in the disclosure due to Wakai disclosure that the browser to function as conversion mechanism without disclose as to how this conversion is accomplished; applicant's arguments have fully been considered, but are not found to be persuasive.

The examiner respectfully disagree, as Wakai's Figure 2 in association with the corresponding explanation in the detail description for Figure 2 does teach/suggest that the above claimed feature, as in accordance to the preceding office action, Wakai teaches receiving a request to provide a request service (e.g. request for printing service), wherein the request is received from an applet (Fig. 2, ref. 202, 203) executing

on a remote network node (Fig. 2, ref. 102) (Fig. 2; Fig. 7 and col. 14, ll. 41-55), as the request to provide the printing service is transferred from the web browser (Fig. 2, ref. 202, 203) and received by the web server (Fig. 2, ref. 204), wherein the web browser (Fig. 2, ref. 202, 203) resides on the remote network node of the client component (Fig. 2, ref. 102 and Fig. 7, ref. 706).

3. In responding to applicant's arguments (on page 12, 2nd paragraph to page 13, 1st paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that the combination of reference do not teach "... selecting a first device of a plurality of device to provide the requested service, wherein ... said selecting is performed in response to said obtaining the resulted of parsing ..." because Wakai does not teach/suggest the language parser, therefore Wakai cannot provide the claimed selection "in response to said obtaining the result of parsing"; applicant's arguments have fully been considered, but are not found to be persuasive.

Please note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, the examiner is relying on Tso for the teaching of the language parser (Fig. 3, ref. 22), wherein Tso teaches selection by invoking the transcode service provider in response to the result of parsing (col. 3, ll. 8-65).

4. In responding to applicant's arguments (on page 12, 2nd paragraph to page 13, 1st paragraph and page 14, 3rd paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that the combination of reference do not teach "... selecting a first device of a plurality of device to provide the requested service, wherein ... said selecting is performed in response to said obtaining the resulted of parsing ..." because the office action present logical inconsistency as the office action is stating that selection is inherently taught by Wakai , but at the same time admitting that Wakai fails to provide such functionality; additionally, if Wakai does teach the selecting then it would be cumulative to utilized a secondary reference (i.e. Tso) in the rejection; applicant's arguments have fully been considered, but are not found to be persuasive.

Please note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, the examiner is relying on Wakai for the teaching/suggesting of selecting the device from the plurality of devices, but said selection is not expressly associated with the language parser, and Tso teaches/suggests selection in association with the language parser; therefore, the resulting combination of references teaches selecting the device from the plurality of devices in association with the language parser.

5. In response to applicant's arguments (on page 13, 2nd to 3rd paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a)

that Wakai does not inherent teach/suggest the claimed "selecting"; applicant's arguments have fully been considered, but are not found to be persuasive.

The examiner respectfully disagree, as Wakai teaches the system (Fig. 2 and Fig. 7) wherein the client (Fig. 2, ref. 102 and Fig. 7, ref. 706) is coupled to the plurality of devices (printer 702, scanner 704, multi-function device 705 of Fig. 7) on the network (Fig. 7, ref. 701), wherein the client select the printer (Fig. 7, ref. 702) as the print button is selected and generating the corresponding print request; therefore, selecting a local printing apparatus as an apparatus for processing the print request (Fig. 2; Fig. 7; col. 13, ll. 3-5 and col. 14, ll. 41-55).

6. In response to applicant's arguments (on page 13, 3rd paragraph and page 14, 3rd paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that the combination of Wakai and Tso would not provide the functionality claimed because Wakai's desktop PC does not receive requests generated by an applet, nor does Wakai teaches a request to be provided by an applet executing on a remote network node; applicant's arguments have fully been considered, but are not found to be persuasive.

The examiner respectfully disagree, as Wakai's desktop PC (Fig. 2, ref. 102 and Fig. 7, ref. 706) does receive requests generated by an applet (Fig. 2, ref. 202, 203) (Fig. 2; Fig. 7 and col. 14, ll. 41-55), as the web browser provided the printing request to the desktop PC before being transfer over the network; wherein the web browser (Fig.

2, ref. 202, 203) is executing on the remote network node of the client component (Fig. 2, ref. 102 and Fig. 7, ref. 706).

7. In response to applicant's arguments (on page 14, 3rd paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that the combination of Wakai and Tso would not provide the functionality claimed because there is not suggesting within Tso that Tso's parser would function in the environment provided by Wakai or what such a parser's function would be in such an environment; applicant's arguments have fully been considered, but are not found to be persuasive.

The examiner respectfully disagree, as Tso's parser functions in the network environment very much similar to Wakai's network environment; further more, it is well known to one skilled in the art to have the language parser to function in association with the browser in the network environment (Tso, Fig. 5).

8. In response to applicant's arguments (on page 14, last paragraph to page 15, 1st paragraph regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that the examiner has not satisfied the burden of factually supporting the alleged motivation to combined the references as suggested by the U.S. supreme court in *KSR International Co. v. Teleflex, Inc.*; applicant's arguments have fully been considered, but are not found to be persuasive.

The examiner respectfully disagree, as in accordance to rationale A, Wakai teaches a network client having the web browser (Wakai, Fig. 2), but Wakai does not

explicitly teach the language parser in association with the web browser on the network client. Tso teaches the language parser utilized in the network environment (Fig. 3), wherein it is well known to one skilled in the art that the language parser is associated with the web browser on the network client (Fig. 5). All of the components are known in Wakai and Tso, wherein Tso expressly teaches/suggests the combination of the "old elements" by having the language parser associated with the web browser on the network client. Therefore, it would have been obvious to include Tso's language parser into Wakai's server component not only because such implementation is well known in the art, but also for the benefit of enabling the manipulation of transferred data between the client computer and the network computer without changing existing hardware (Tso, col. 1, ll. 24-40).

9. In response to applicant's arguments (on page 15, last paragraph) regarding the independent claims 1, 9, 16, 23 and 30 rejected under 35 U.S.C. 103(a) that there is no motivation to combined the references; applicant's arguments have fully been considered, but are not found to be persuasive.

The examiner respectfully disagree. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

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Cir. 1992). In this case, not only is the association of the language parser with the web browser on the client well known to one skilled in the art (Tso, Fig. 5), the combination also provide the benefit of enabling the manipulation of transferred data between the client computer and the network computer without changing existing hardware (Tso, col. 1, ll. 24-40).

I. REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wakai et al. (US Patent 6,587,126) in view of Tso et al. (US Patent 6,421,733).

11. As per claims 1, 9, 16, 23 and 30, Wakai teaches a computer-readable medium system and method comprising:

a processor (CPU 802 of Fig. 8) configured to execute instructions;

a plurality of devices (e.g. printer 702, scanner 704, multi-function device 705 of Fig. 7) directly coupled to the computer system (Fig. 7, ref. 706), wherein each device is configured to perform a corresponding function (e.g. printing function, scanning

function) (col. 15, l. 58 to col. 16, l. 5), wherein the plurality of devices are directly coupled to the computer system over the network (Fig. 7, ref. 701); and

a memory (Fig. 8, 805-807), coupled to the processor (Fig. 8, ref. 802), and configured to store the instructions, wherein the instructions comprise:

a module of receiving instructions (web server 204 of Fig. 2) configured to receive a request to provide a requested service (e.g. service of printing), wherein the request is received from an applet (Fig. 2, ref. 202, 203) executing on a remote network node (Fig. 2, ref. 102) and the request conforms to a request format defining in a first language (col. 14, ll. 41-47), wherein the request to provide the service of printing is transferred from the web browser (Fig. 2, ref. 202, 203) to the web server (Fig. 2, ref. 204) conforming to the language utilized by the web browser, such as HTML (Fig. 132),

at least one device (printer 702 of Fig. 7) of the plurality of devices (printer 702, scanner 704, multi-function device 705 of Fig. 7) is configured to provide the requested service (e.g. service of printing), wherein the plurality of devices comprising the printer, the scanner and the multifunction device;

providing the request to a server component (Fig. 2, ref. 103);

a module of selecting instructions (i.e. selecting therefore identifying) configured for selecting (identifying) a first device (e.g. printer) of the plurality of device (i.e. at least one device) to provide the requested service (e.g. service of printing) (Fig. 32, ref. S3201) (col. 3, ll. 3-5), and

the module of selecting instructions (i.e. selecting therefore identifying) are inherently performed in response to the module of obtaining request instruction, as

there is more than one option that the request may be directed including the option to request for scanning by the scanner (Fig. 7, ref. 704) and the option to request for printing by the printer (Fig. 7, ref. 702); therefore, only after obtaining the request and determining the type of request (e.g. scanning or printing) by the desktop's PC's processor or the like, can the received request be properly routed to the correct peripheral device over the network (Fig. 7, ref. 701); and

a module of converting instructions (request manager 207 of Fig. 2) configured for converting the request to a second request in a second language (process command comprising the print command) (col. 14, ll. 47-55), wherein the request manager converts the request to the corresponding process command;

wherein the second request conforms to a request format defined in a second language (i.e. language associated with process command) (col. 14, ll. 47-55);

the first device (the printer comprising server component 103 and printer 206 of Fig. 2 and col. 15, ll. 12-17) is configured to provide the requested service (e.g. service of printing) in response to receiving the second request (process command comprising the print command) (col. 14, ll. 47-55), wherein the service of printing is performed when the printer's command analysis/process unit (Fig. 2, ref. 208) receives the print command.

Wakai does not teach the computer-readable medium system and method comprising a language parser configured to parse the first language; obtaining results of the parsing the request from the language parser; and selecting performed in response to the result of the parsing.

Tso teaches a system and a method comprising:

a language parser (Fig. 3, ref. 22) configured to parse the first language (e.g. HTML); obtaining results of the parsing the request from the language parser; and selecting (e.g. selectively invoking the transcode service provider) performed in response to the result of the parsing (col. 3, ll. 8-65).

It would have been obvious for one of ordinary skill in this art, at the time of invention was made to include Tso's parser into Wakai's server component for the benefit of enabling the manipulation of transferred data between the client computer and the network computer without changing existing hardware (Tso, col. 1, ll. 24-40) to obtain the invention as specified in claims 1, 9, 16, 23 and 30.

12. As per claim 2, Wakai and Tso teach all the limitations of claim 1 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising directing the second request (process command comprising the printing command) to the first device (printer) (Wakai, col. 14, 47-55), as the second request (process command) is directed to the printer's command analysis/process unit (Wakai, Fig. 2, ref. 208).

13. As per claim 3, Wakai and Tso teach all the limitations of claim 2 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising:

the first language is a mark up language (Wakai, Fig. 10 and col. 14, ll. 41-47), as the request is transferred by the web browser (Wakai, Fig. 2, ref. 202, 203) over the network to the web server (Wakai, Fig. 2, ref. 204) utilizing language such as HTML (Wakai, Fig. 132);

the second language is a device specific language of a plurality device specific languages (Wakai, Fig. 7 and col. 16, ll. 56-60), wherein process command comprising the print command and the scan command, as the print command would be specific for the printer and the scan command would be specific for the scanner,

wherein each of the plurality of devices communication using one of the plurality of device specific languages (Wakai, Fig. 7 and col. 16, ll. 56-60).

14. As per claim 4, Wakai and Tso teach all the limitations of claim 2 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising wherein the request formats comprise:

at least one instruction (instruction to print) (Wakai, col. 17, ll. 8-14), and
data (print information) to be used when performing the at least one instruction (Wakai, col. 17, ll. 8-14).

15. As per claim 5, Wakai and Tso teach all the limitations of claim 4 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising:

specifying use of a specific feature (printing feature) of the first device (Wakai, printer 702 of Fig. 7) (Wakai, Fig. 22 and col. 14, ll. 51-55),

wherein said specifying use of the specific feature comprises specifying a optional variable (variable of "Print") (Wakai, Fig. 22 and col. 23, ll. 59-63) and

providing a value (value of data file to be printed) for the optional variable (Wakai, Fig. 132 and col. 45, ll. 19-22), wherein the data file to be printed is provided by specifying the specific data file; therefore, the optional variable and the value specify use the specific feature of the first device; and

said converting the request to the second request comprises:

including the optional variable in the at least one instruction of the second request, and including the value for the optional variable in the data of the second request (Wakai, Fig. 132 and col. 45, ll. 19-22), wherein the user requests service of printing of the specific data file by selecting the "print" on screen with the specific data file, therefore the second request comprises of the "print" request and the data file to be printed.

16. As per claim 6, Wakai and Tso teach all the limitations of claim 2 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising sending a response to the request (Wakai, Fig. 22, ref. S2213), as the HTML page corresponds to the printing is transferred to the client component.

17. As per claim 7, Wakai and Tso teach all the limitations of claim 6 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising wherein the response conforms to a response format defined in the first language (HTML format) (Wakai, Fig. 22, ref. S2213).

18. As per claim 8, Wakai and Tso teach all the limitations of claim 7 as discussed above, where Wakai further teaches the computer-readable medium system and method comprising wherein the response formats comprises:

at least one instruction (Wakai, Fig. 22, ref. S2213), wherein the instruction comprising the instruction to display the corresponding HTML page; and

data to be used when performing the at least one instruction (Wakai, Fig. 23, ref. S2312, S2313 and col. 24, ref. 45-49), wherein the data to be used comprising "Printing successful" and "Printing failure".

19. Claims 10-15, 17-22, 24-29 and 31-36 repeat the limitations of claims 2 and 4-8 and are therefore rejected accordingly.

II. CLOSING COMMENTS

Conclusion

a. STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. 707.07(i)**:

a(1) CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 1-36 have received a final action on the merits. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

b. DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun-Kuan (Mike) Lee whose telephone number is (571) 272-0671. The examiner can normally be reached on 8AM to 5PM.

IMPORTANT NOTE

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alford Kindred can be reached on (571) 272-4037. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 10, 2008

Chun-Kuan (Mike) Lee
Examiner
Art Unit 2181

/Alford W. Kindred/

Supervisory Patent Examiner, Art Unit 2163